

## **REMARKS**

Claims 1-2, 5-8, 9-12, and 14 are currently pending in this application. Claims 1-2, 5-8, and 9-12 stand rejected from the final Office Action dated August 6, 2003, and the Advisory Action dated December 12, 2003. Claims 1 and 12 have been amended and Claim 14 is a new claim added in this Preliminary Amendment. Applicants filed a Notice of Appeal on January 6, 2004, and have filed this Amendment along with a Request for Continued Examination.

### **Examiner's Interview**

Applicants wish to thank the Examiner and his supervisor, David Wu, for the interview with Robert Stanley on February 25, 2004. In furtherance of that interview and in light of the Interview Summary dated March 22, 2004, Applicants present the following arguments and amendments to the claims and specification.

### **Objection under 35 U.S.C. § 132**

In the Office Action dated August 6, 2003, the Examiner objects to the April 16, 2002, amendment of the paragraph bridging pages 36-37 as introducing new matter into the specification. The Examiner continues this rejection in the Advisory Action dated December 12, 2003. Specifically, the Examiner believes that the original specification states that Bionolle #1020 contains 30% talc as purchased, while that amendment states that Bionolle #1020 has 30% talc added to it.

As indicated by the Interview Summary, Applicants presented additional arguments concerning this new matter rejection. At the suggestion of the Examiner,

Applicants have herein amended the paragraph to indicate clearly that Bionolle #1020 does not contain talc as purchased. Instead, 30% talc by weight was added to the Bionolle #1020 to obtain a talc-containing aliphatic polyester type biodegradable resin prior to any admixture of that resin with a polylactic acid. With the previous arguments and the amendment to Example 2 of the specification provided herein, Applicants believe that this rejection has been overcome. Applicants submit that no new matter is added with this amendment and respectfully request that the rejection withdrawn.

**Rejections over Tsai et al.**

The Examiner rejects claims 1-2, 5-6, 8, and 10-12 under 35 U.S.C. § 102(e) as anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,910,545 to Tsai et al. As indicated by the Interview Summary, Applicants presented additional arguments concerning this rejection over Tsai et al. Specifically, Applicants previously submitted a Declaration Under 37 C.F.R. § 1.131 of Yoshifumi Miyajima dated May 2, 2002. The Declaration cites and summarizes an invention report dated October 31, 1997, showing that Applicants reduced to practice the presently claimed invention before the effective date of Tsai et al. In the interview, the Examiner agreed to accept the Declaration to overcome Tsai et al. and remove it as a reference under both 35 U.S.C. § 102(e) and § 103(a). With the accepted Declaration, Applicants respectfully request that these rejections be withdrawn.

### **Rejections over Obuchi et al.**

The Examiner has continued to reject claims 1-2, 5-6, 8, and 10-12 under 35 U.S.C. § 102(e) as anticipated by, or, in the alternative, under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,916,950 to Obuchi et al. Applicants respectfully traverse these rejections.

In order to anticipate the pending claims of this application, a reference must disclose, either expressly or inherently, each and every element in the claims. See MPEP § 2131. In order to render obvious the pending claims of this application, a reference must be considered in its entirety, including any portions may rebut a *prima facie* obviousness determination by leading one of ordinary skill in the art away from the claimed invention. See MPEP §§ 2141.02 and 2145(X)(D). Obuchi et al. states, “[i]t is important in the invention that polyester (A) contains 25-75% of the lactic acid component” (col. 7, lines 10-11). Further, the reference specifically teaches away from its resin compositions containing less than 25% of a lactic acid component (col. 7, lines 20-24) (see also Interview Summary, ¶ 2).

With the amendments herein, Applicants have amended claims 1 and 12 to recite that the polylactic acid accounts for a proportion in the range of 5% to less than 25% by weight of the material. No new matter has been added by these amendments.

Applicants submit that Obuchi et al. does not anticipate the pending claims as it does not disclose a resin containing polylactic acid in an amount less than 25%. Further, the reference does not render obvious the pending claims as it in fact teaches away from a resin that contains less than 25% polylactic acid. Because Obuchi et al. does not disclose or suggest a resin with less than 25% polylactic acid, as recited by the pending

claims, Applicants respectfully request that the rejections over this reference be withdrawn.

#### **Rejection over Yamada et al.**

In the Final Office Action dated August 6, 2003, the Examiner rejects claim 7 under 35 U.S.C. § 103(a) as obvious over Obuchi et al. or Tsai et al. in further view of JP 09-041220 to Yamada et al. With the arguments and amendments presented above, Applicants have shown that neither Obuchi et al. nor Tsai et al. serves to render obvious the pending claims. Applicants now submit that Yamada et al. does not remedy the deficiencies of these references and cannot by itself render obvious the invention recited in claim 7. As a result, Applicants request that this rejection be withdrawn.

#### **New Claim 14**

Applicants have added claim 14 with the present amendment. Claim 14 recites a molded article comprising an interlocking fastener component made of a biodegradable resin material that does not contain an inorganic filler. Applicants submit that the references of record neither anticipate nor render obvious this claim, that no new matter has been added by the submission of this claim, and respectfully request its allowance.

#### **Conclusion**

In view of the foregoing remarks and amendments, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the references cited against this application. Applicants therefore request the entry of

this Amendment, the Examiner's reconsideration and the continued examination of the application, and the timely allowance of all the pending claims. If, after consideration of this Preliminary Amendment, the Examiner does not believe this application to be in condition for allowance, Applicants kindly request that the Examiner contact either the undersigned at 404-653-6456 or Robert Stanley at 404-653-6441 to discuss an appropriate resolution and the further prosecution of this application.

Please grant any extensions of time required to enter this Preliminary Amendment charge any fee due in connection with this filing to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 6, 2004

By: 

Barry D. Biddle  
Reg. No. 44,033